

### **REMARKS**

Claims 1-27 are now pending in this application. Claims 1, 8, 18, 20, and 21 are independent. Claims 1-17 have been amended, and claims 18-27 have been added by this amendment. No new matter is involved with any claim amendment or new claim.

### **Claim Objections**

Withdrawal of the objection to claims 4-7 and 10-17 is requested. These claims have been amended in a manner which is believed to overcome the stated bases for objection.

Withdrawal of the objection to improperly numbered claims "1-3" submitted on March 6, 2002 is requested. New claims 18-24 have been drafted to replace the improperly numbered claims, and to further define that which Applicants regard as their invention. Improperly numbered claims "1-3" are withdrawn.

### **Anticipation Rejection Over Micali**

Withdrawal of the rejection of claims 1-3 and 8-9, under 35 U.S.C. 102(b) as being anticipated by Micali (US Patent No. 5,473,254) is requested. These claims have been amended in a manner which is believed to better conform to U.S. practice.

Applicant notes that anticipation requires the disclosure, in a prior art reference, of each and every limitation as set forth in the claims.<sup>1</sup> There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. §102.<sup>2</sup> To properly anticipate a claim, the reference must teach every element of the claim.<sup>3</sup> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference".<sup>4</sup> "The identical invention must be shown in

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<sup>1</sup> *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985).

<sup>2</sup> *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (Fed. Cir. 1991).

<sup>3</sup> See MPEP § 2131.

<sup>4</sup> *Verdegaal Bros. v. Union Oil Co. of Calif.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

as complete detail as is contained in the ...claim.”<sup>5</sup> In determining anticipation, no claim limitation may be ignored.<sup>6</sup> The applied art fails to meet this threshold burden, as further discussed below.

The applied art discloses at least at col. 4, lines 25-32 and FIG. 1 that both the functions  $G_0$  and  $F_0$  depend on the message  $M$  because  $\sigma$  has been computed on input  $M$ , and that the signature  $(z, \sigma)$  of message  $M$  consists of a value  $z$  and the description of a function  $F_0$  which depends on  $M$ . In other words, the apparatus and method of Micali uses the data message itself to create the digital signature.

In contrast, Applicants’ disclosed and claimed invention provides a signature that is independent of any message or content of a document, i.e., the signature is *independent* of the contents of the document being issued. In practical terms, Applicants’ approach allows for a much more reasonably sized digital signature than that generated by the apparatus and method disclosed in Micali, while still providing desired levels of security.

Specifically, the applied art does not disclose a security module that includes, among other features, “...a second combination machine including second means for generating and transferring a second result value via a second data output port to a document to be issued, wherein the second result value is independent of any information in the document to be issued”, as recited in independent claim 1, as amended.

Further, the applied art does not disclose a method for producing a forgery-proof document to be issued, wherein, among other features, “...the combination of data representing the secret and the input data is determined independently from contents of the individual document”, as recited in independent claim 8, as amended.

Accordingly, since the applied art does not disclose all the claimed features of independent claims 1 and 8 as amended, reconsideration and allowance of these claims is

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<sup>5</sup> *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

respectfully requested.

Further, since dependent claims 2-7 and 9-17 variously and ultimately depend from allowable claims 1 and 8, these claims are submitted as being patentable at least on that basis, without recourse to the further patentable features recited therein. Allowance of claims 2-7 and 9-17 are also requested.

### **New Claims**

New claims 18-27 have been drafted in a manner that avoids the applied art. No new matter is involved with any new claims. Support for these claims may be found at least at p. 1, lines 18-31, page 3, line 13 through p. 4, line 6, page 6, line 8 through page 7, and FIG. 1 of the originally filed disclosure.

Consideration and allowance of claims 18-27 are respectfully requested.

### **Conclusion**

In view of the above amendment and remarks, Applicants believe that each of pending claims 1-27 in this application is in immediate condition for allowance. An early indication of the same would be appreciated.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number indicated below.

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<sup>6</sup> *Pac-Tex, Inc. v. Amerace Corp.*, 14 USPQ2d 187 (Fed. Cir. 1990).

For any fees that are due, including fees for extensions of time and excess claims, the Director is hereby authorized to charge any fees or credit any overpayment during the pendency of this application to CBLH Deposit Account No. 22-0185, under Order No. 10096-00001-US from which the undersigned is authorized to draw.

Date: May 26, 2006

Respectfully submitted,

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